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May 23, 2000

Davis Pan
Compaq Computer Corporation
One Cambridge Center
Cambridge, MA 02421-1612

Re: Review of Patent Application
Our Reference No: 0918.2013-000
Compaq Reference No: PD99-2759
Title: "Method and System for Linking User Input with Streaming Data," by Pan, *et. al.*

Dear Davis:

A draft patent application is attached for your review. I would appreciate your reviewing the application carefully and providing any corrections directly on the draft. Specific changes are generally preferred over general comments to expedite putting the application in final form, but please feel free to call if anything should be discussed.

The application is formatted as follows:

- a) The background section includes only information that we are willing to accept as prior art and which is required to set the stage for a description of your invention. This section should be brief and usually should not include a discussion of the problem to be solved, since recognizing the problem is sometimes part of the inventive process.
- b) The summary of the invention section is a "non-legalese" paraphrase of the claims with some added discussion where needed for clarity.
- c) The detailed description section fulfills several purposes. It must describe the invention in sufficient detail to enable a person skilled in the art to make and use the claimed invention without undue experimentation.

This section also serves to provide support for the claims by stating alternatives and advantages and by clarifying the

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distinctions over the prior art. Note that by describing your invention in detail, you are not limiting the scope of your invention. Only the claim language limits the scope of coverage.

Further, the detailed description section serves to meet the "best mode" requirement. The "best mode" requirement goes further than the "enablement" requirement in that it requires you to include in the patent application a description of the best mode contemplated by you in practicing your invention.

Failure to comply with the "best mode" or "enablement" requirements is not usually correctable, and will invalidate a patent that might issue from such a defective application.

- d) The claims are the legal definition of the invention. You can see that they go from very broad independent claims, such as Claim 1, through very specific dependent claims. Within the dependent claims we have not included every possible permutation because the Patent Office charges significant fees for additional claims beyond twenty. PLEASE CAREFULLY REVIEW, UNDERSTAND AND CRITIQUE THESE CLAIMS. Note that if any element or step in an independent claim is not found in a competitor's structure, the claim is avoided. Consider how you would avoid the claims I have drafted.

We are obliged to present to the Patent Examiner all known information which is material to patentability. I would appreciate your providing copies of and describing the pertinence of any material prior art or other information of which you are aware and which you have not already provided to us.

Lastly, my understanding is that the inventorship in this application is as follows:

Davis Pan and James Rehg

Please indicate who is to be listed as the first or primary inventor.

Only persons who have made an inventive contribution to the conception of at least one of the claims in the patent application should be listed as an inventor. Any doubts on this matter should be resolved with me before proceeding further. Intentional failure to correctly name inventors could result in an invalid or unenforceable patent.

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I look forward to receiving your comments so that we can file this application well before any disclosure of the invention.

Thank you for your help.

Very truly yours,

HAMILTON, BROOK, SMITH & REYNOLDS, P.C.

By Paul P. Kriz
Paul P. Kriz

Enclosure

cc: James M. Smith, Esq.

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